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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,942	08/22/2003	Herbert Reed	3752-0083	8244

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EXAMINER
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ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/645,942

Applicant(s)

REED, HERBERT

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,11,13,16,17 and 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-10,12,14,15,18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-10, 12, 14, 15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Southerland, Jr. for substantially the same reasons stated in the first Office Action.

The patent to Southerland shows a modular weight for a fishing lure having a head 2 and at least one protrusion 5. The protrusion has a first end 6 and a second end 9. The first end is coupled to the head 2 as shown in Fig. 5 or Fig. 7. The protrusion is sized for lengthwise insertion into a fishing lure 20. The protrusion is independent of the fishing line, the hook, and connecting hardware. Southerland shows the modular weight made from metal in column 1, line 20. All metals have a density greater than that of water. In reference to claims 2 and 3, Southerland shows the head as rounded and spherical. In reference to claim 4, Southerland shows the head is decorated to resemble at least one aspect of typical bait. In reference to claim 7, Southerland shows the head coupled to at least one protrusion such that the protrusion is not intended to be separated from the head during normal use. In reference to claim 8, Southerland shows the head fabricated from one unit of common material. In reference to claim 9, Southerland shows the head is molded onto at least one protrusion in Fig. 7. In

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reference to claim 10, Southerland shows the second end of the protrusion as pointed in Fig. 5 and Fig. 7. In reference to claim 12, Southerland shows the body portion at the least one protrusion as round. In reference to claim 14, Southerland shows the body portion of the protrusion as contoured to point 9 at the second end. In reference to claim 15, Southerland shows a rib 10. In reference to claim 19, Southerland shows the head and the protrusion made from the same materials in column 1, line 20.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Southerland, Jr. for substantially the same reasons stated in the first Office Action.

The patent to Southerland shows a fishing lure as discussed above. Southerland discloses making the modular weight out of plastic or metal, but does not disclose making the weight out of different materials. However, it would have been obvious to make the weight out of different materials since the selection of known materials is based on their suitability for the intended use. See *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

5. Applicant's arguments filed Oct. 22, 2004 have been fully considered but they are not persuasive. In response to applicant's argument that Southerland is nonanalogous

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art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Southerland is in the field of applicant's endeavor since both the present invention and Southerland deal with fishing lures and modifications to existing lures. It should be pointed out that the eyes of Southerland have mass and therefore weight and hence, can be considered as weights. Further, applicant speculates that the eyes of Southerland must have a specific gravity less than that of water. However, no where in Southerland does it say that. Southerland discloses that the eyes are made from plastic or metal. Since the eyes are solid, the specific gravity would have a density higher than that of water noting that most plastics have a specific gravity of between 2 and 3. Most metals that would commonly be used have specific gravities from almost 3 to about 8. Applicant then infers that since the eyes are located on the top of the lure, that if the specific gravity was greater than that of water, that the would tend to orient itself upside down. This is simply incorrect since the weight of the eyes is much less than the weight of the lure. The effect of the eyes would be very small at most. Southerland discloses that the eyes can be metal and it is not seen how they could have a specific gravity of less than water. Since Southerland does not include weights on the bottom portion of the lure, the conclusion that can be drawn is that the eyes do not cause the lure to invert. Since the lure does not invert, the addition of the eyes has not effect on the orientation of the lure. Southerland does suggest a modular weight for

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a fishing lure and is therefore a sufficient teaching to render claim 18 obvious when combined with the knowledge of one skilled in the art.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR